REMARKS

Claims 1-49, 55, 57, 58, 60, 61, 64-68, 73 and 77-92 are pending. By this Amendment, claim 59 has been canceled, and claims 60, 61, 73, 84, 87, 89 and 92 have been amended. (Claim 92 is amended for clarity only for better antecedent basis for "the steering shaft.") In addition, a Request for Approval of Drawing Corrections is presented herein which requests approval for corrections to marked-up Figs. 2 and 3, attached hereto.

This Amendment is being filed after the filing of the Notice of Appeal on November 25, 2002. While Applicants still intend on filing the Appeal Brief, if necessary, this Amendment is being filed to reduce the issues presented for Appeal. Moreover, this Amendment should be entered as a matter of right because the Office Action of November 14, 2002 was made "final" prematurely. For example, the Office Action (see the sentence bridging pages 3 and 4) for the first time rejects claims 73, 85, 88, 89, 91 and 92 allegedly because "the position of the toe holds in a vertical plane above the rider's toes is new matter." Applicants' Amendment did not necessitate a new grounds of rejection, as discussed more fully below.

This Amendment is not intended to be a full reply to the November 14 Office Action, but is merely presented to reduce issues for appeal. However, all rejections are at least mentioned in the discussion that follows.

DRAWING CORRECTIONS

The drawing corrections filed on May 22, 2002 were not approved, allegedly because they introduce new matter. Specifically, the suggested change to position the windshield further away from the handlebars in Figures 2 and 3 was not approved. However, support for this change is found in Applicants' Canadian application no. 2,256,944 (copy enclosed), of which this application claims priority. (The Canadian application is incorporated by reference

in its entirety in the first paragraph of this application.) Specifically, reference is made to Figure 9 which shows the position of the windshield according to the present invention, which was shown in Figures 2 and 3 of the present application, albeit in a manner to which the Examiner objected.

The proposed drawing corrections filed on May 22, 2002 are consistent with Figure 9 of the Canadian priority document since both show the handle bars or steering device spaced from the windshield. The drawings from the Canadian application are substantially similar to the schematic drawing in Appendix C of Robert Handfield's Declaration filed July 9, 2002. In the Office Action, the Examiner commented, in reference to the schematic drawing in Appendix C, that "that schematic drawing ... shows the steering member in a position which would allow significant steering." See page 8, last paragraph.

The proposed corrections submitted herewith include the same changes as were presented on May 22, 2002, but, to address the Examiner's concern, the windshield from Figure 9 of the Canadian application has been adopted instead of Applicants' previous depiction of the windshield position. Moreover, the windshield position as shown in the attached proposal is consistent with the original specification and claims in that the angle between the top of the windshield and the seat position closely approximates the angle μ in the range of 10-20 degrees, preferably 18 degrees, as stated in claims 55 and 57 and page 14, lines 3-6.

The Office Action also errs when it states on page 3 that "Applicant has not disclosed the many required elements of a working snowmobile." The only example for supporting this broad statement relates to the steering device abutting against the windshield, which is not the case as explained above. Moreover, a review of the specification and drawings reveals that an incredible amount of detail is provided regarding dimensions, angles, etc. for the

snowmobile. See, e.g., the many angles shown in Figures 2, 3, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17 and 18 and the corresponding descriptions thereof, and the dimensions (between various portions of the snowmobile seat, steering device and footrest) shown in Figures 2, 6, 11 and the corresponding descriptions thereof. Also, Figures 19 and 20 provide every possible human parameter that could conceivably be necessary to make the snowmobile recited by the claims.

Therefore, Applicants respectfully request that the Drawing Corrections be approved since the proposals are supported in the original specification and do not add new matter.

112 (1) REJECTION

Claims 1-49, 55, 57-61, 64-68, 73, and 76-84 were rejected under 35 U.S.C. §112, first paragraph. Claim 76 was canceled by the September 24, 2001 Amendment. Otherwise, this rejection is respectfully traversed.

The Request for Approval of Drawing Corrections discussed above obviates the rejection as it relates to the disclosure of a steerable snowmobile.

Withdrawal of the rejection is respectfully requested.

Claims 73, 85, 88, 89, 91 and 92 are rejected under rejected under 35 U.S.C. §112, first paragraph, as containing new matter. This rejection is respectfully traversed.

This rejection alleges that there is no disclosure for the tunnel or the toe-holds in a vertical plane above the rider's toe.

With regard to the tunnel, the complete structure of the tunnel shown in Figures 5-18 of the original application. The tunnel is also shown and described in the Canadian priority application. See Figures 10-13, 16, 20, 21 and 22 and page 3 ("the rear of the main frame is the standard unibody frame with a tunnel therein") and page 9 ("a tunnel area (27) is shown") and claim 2 ("the rear chassis including a tunnel"). The tunnel in the Canadian application

clearly corresponds to that portion of the frame shown in original Figures 5-18. See also Paragraph 45 of the Declaration of Robert Handfield filed July 9, 2002, which states that "the tunnel is shown in Figures 5-18." This statement must be considered.

The tunnel is a structural element of a snowmobile the details of which would be understood readily by those skilled in the art. Moreover, relevant portions of the tunnel are depicted throughout Figures 5-18. In addition, it is interesting to note that Christensen et al. do not use the term "tunnel", yet the Examiner has asserted that Christensen et al. has "... a drive track in a tunnel . . .". See page 5 of the Office Action. Accordingly, Applicants respectfully submit that the positional relationship between the tunnel and other structure on the vehicle is supported by the original disclosure.

With regard to the toe-holds being disposed above the rider's toes in a vertical plane, Applicants respectfully raise the following points.

First, the only language not in original claim 73 was added in the Amendment of September 24, 2001. The Patent Office issued an Office Action on January 22, 2002 but did not include any rejection or objection based on this new language being added. It is improper to reject claim 73 for the first time on this basis and to make the rejection final, thereby limiting Applicants' ability to reply to this rejection. Thus, the Final Rejection is improper and should have been made non-final, to allow Applicants a fair chance to reply. Therefore, all amendments herein must be entered as a matter of right.

Second, the language in claim 73 regarding the toe-holds has been returned to its original form, and therefore cannot constitute new matter. This also reduces issues for appeal.

Third, it is noted that the Examiner has never objected to the toe-hold placement as proposed by Applicants on June 22, 2000, January 12, 2001 and May 22, 2002. In fact, the

drawing corrections have several times been approved by the Examiner. *See, e.g., In re Oda*, 170 USPQ 268, 272 (CCPA 1971) (one skilled in the art would appreciate not only the existence of an error in the specification, but what the error is. As a corollary, it follows that when the nature of this error is known, it is also known how to correct it).

Withdrawal of the rejection is respectfully requested.

112(2) REJECTION

Claims 1-49, 55, 57, 58, 61, 64-68, 77-84, 87 and 90 were rejected under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed.

At the outset, it appears that claim 88 should have been included in this rejection as it depends from claim 40, which is included in the rejection. It appears that the examiner intended to include claim 58 in the rejection as well, since it includes the terms "standard rider" and "standard position". Clarification in the next Office Action is respectfully requested.

The Office Action states that "a rider, a human being, cannot be standardized." See p. 4. While all human beings are unique and different, Applicants are not claiming a human being. Applicant's are claiming certain components of a snowmobile that are designed to accommodate a "50th percentile male" in a more dynamically advantageous position. The 50th percentile male is NOT a human being. It is a standard measure by which infringement can be easily determined for a given snowmobile architecture. Applicants incorporate all arguments presented before in regard to this issue submitted on behalf of Applicant.

Moreover, it is not believed that the recitation of "standard riding position" introduces uncertainty into the claims. In any event, this language has been removed from claims 84 and 87 to reduce issues for appeal for those claims. In fact, claim 84 does not refer to a standard rider or a standard position.

The Examiner also confuses the issue of "indefiniteness", a 112(2) issue, with "undue experimentation", a 103 issue. See page 10 of the Office Action. Undue experimentation has nothing to do with whether the claims are indefinite. Moreover, the specification provides all details necessary to determine whether infringement exists, and to make an operative assembly, as discussed above. It is, however, interesting to note that the Examiner seems to admit that once the snowmobile is made, it would be possible to determine infringement. That seems to satisfy the type of definiteness 112(2) intended to promote.

If the Examiner maintains this rejection, the issue will need to be reviewed by the Appeal Board or in the Appeals conference, which Applicants specifically request if the appeal conference procedure is not automatically scheduled for each appealed application.

Withdrawal of the rejection is respectfully requested.

PRIOR ART REJECTIONS

Claims 60, 61 and 89 were rejected under 35 U.S.C. §102(b) over Christensen et al. This rejection is respectfully traversed.

While Applicants do not agree with the rejection, since, for example, Christensen et al. do not teach a "to-scale" snowmobile, each claim has been amended to recite that "an angle between a line passing through the forward-most drive track axle and the center of gravity and a horizontal line passing through the forward-most drive track axle is less than 55°". This subject matter is not taught by Christensen et al. as the relevant angle in Christensen et al. approximates a 90 degree angle.

The amendments to claims 60, 61 and 89 are entitled to entry as a matter of right as the final rejection was made premature, for reasons detailed above.

Withdrawal of the rejection is respectfully requested.

Claim 85 was rejected under 35 U.S.C. §103(a) over Christensen in view of JA 2-274,681. This rejection is respectfully traversed.

Neither reference discloses the following features from claim 85:

1) an angle between a line passing through the forward-most drive track axle and the center of gravity and a horizontal line passing through the forward-most drive track axle is less than 55° (as discussed above, Christensen et al. shows an approximately 90 degree angle. JP 2-274,681 is silent as to the position of the CG versus the axle); and

2) a center of gravity positioned below the upper-most surface of the tunnel (Christensen et al.'s CG is clearly above the uppermost surface of the tunnel).

It appears that the Examiner intended to reject claim 86 based on the Christensen et al./JP 2-274,681 combination. Clarification is requested. In any event, there is no motivation to combine the teachings of Christensen et al., which clearly shows a flat horizontal foot rest arrangement, with the foot rest arrangement of JP 2-274,618, absent impermissible hindsight based on Applicants' disclosure as a blueprint. The Examiner is merely picking and choosing elements from each reference to meet the claims without any motivation for doing so. Further, JP-2-214,618 does not teach or suggest that the sideboards have a forward portion disposed at an angle prescribed in claim 86, or the toe-holds recited in claim 86. These features are discussed immediately below.

Withdrawal of the rejection is respectfully requested.

Claim 73 was rejected under 35 U.S.C. §102(b) over JP 2-214,618. This rejection is respectfully traversed.

Claim 73 recites that the forward portion of each sideboard is disposed at an angle from horizontal that is between -5° to -10°, and toe-holds.

JP 2-214,618 does not disclose the claimed angle of between -5 and -10 degrees. The reference is silent as to any angle of the footrest, the disclosure being directed to a storage compartment and the heating of the footrest area to comfort the rider and melt snow on the footrest area.

However, the Examiner states that the sideboards are angled at approximately 6 degrees from horizontal. It is impermissible to measure the angle, absent a statement that the drawings are drawn to scale. See MPEP 2125 ("When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on mere measurements of the drawings appears to us of little value") and *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.").

There is no statement in JP 2-214,618 that the drawings are to scale. Moreover, the reference is silent as to the angle. A complete translation of the reference is enclosed for the Examiner's convenience.

In addition, JP 2-214,618 does not teach that left and right toe holds ... for allowing the rider to releasably secure himself to the snowmobile. JP 2-214,618 discloses nothing for allowing the rider to releasably secure himself to the snowmobile. The front surface of the foot rest does not constitute a "toe-hold" according to its well known meaning in the art. If one of ordinary skill in the art were to provide JP 2-214,618 with a toe-hold, Applicants respectfully submit that that toe-hold would look like the toe-hold of Prior Art Figure 1 of Applicants' Canadian priority application, which includes a positively inclined footrest area for each foot.

Withdrawal of the rejection is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached Appendix is captioned **"Version with markings to show changes made"**.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance/appeal, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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PTB
Enclosures:
Appendix
Request for Approval of Drawing Corrections
Copy of Canadian Priority application
Translation of JP 2-214,618

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Cancel claim 59 without prejudice or disclaimer.

Please amend claims 60, 61, 73, 84, 87, 89 and 92 as follows:

60. (Four Times Amended) A snowmobile, comprising:

a frame having a forward-most drive track axle disposed thereon;

a straddle seat disposed on the frame;

an engine disposed on the frame in front of the seat;

two skis disposed on the frame; and

a steering device disposed on the frame and operatively connected to the two skis for steering the snowmobile;

wherein the snowmobile has a center of gravity without a rider and the steering device is disposed on the frame forward of the center of gravity, and wherein the forward-most axle is positioned forward of the center of gravity and rearward of a rearward-most portion of the steering device such that the center of gravity is rearward of the rearward-most portion of the steering device, and

wherein an angle between a line passing through the forward-most drive track axle and the center of gravity and a horizontal line passing through the forward-most drive track axle is less than 55°.

61. (Four Times Amended) A snowmobile, comprising:

a frame having a forward-most drive axle mounted thereon;

a straddle seat disposed on the frame, the seat being dimensioned to support a standard rider in a standard position in which the standard rider straddles the seat while the snowmobile is heading straight ahead on flat terrain, the standard rider having dimensions and weight of a 50-percentile human male;

an engine disposed on the frame in front of the seat;

two skis disposed on the frame; and

a steering device disposed on the frame and operatively connected to the two skis for steering the snowmobile;

wherein the snowmobile is adapted to have a center of gravity with a rider in the standard position such that the steering device and the forward-most drive axle are disposed on the frame forward of the center of gravity, and such that the forward-most drive axle is positioned rearward of a rearward-most portion of the steering device so that the center of gravity is rearward of the rearward-most portion of the steering device, and

wherein an angle between a line passing through the forward-most drive track axle and the center of gravity and a horizontal line passing through the forward-most drive track axle is less than 55°.

73. (Four Times Amended) A snowmobile, comprising:

a frame;

a straddle seat disposed on the frame;

an engine disposed on the frame in front of the seat;

two skis disposed on the frame;

a steering device disposed on the frame and operatively connected to the two skis for steering the snowmobile; and

right and left sideboards extending laterally from the frame below the seat on either side thereof, each of the sideboards having a forward portion suitable for placement of a rider's foot thereon, the forward portion of each sideboard disposed at an angle Δ with horizontal that is between –5° to -10°; and

right and left toe-holds disposed respectively above the [rider's toes in a vertical plane] forward portion of each sideboard for allowing the rider to releasably secure himself to the snowmobile.

84. (Amended) A snowmobile, comprising:

a frame;

an engine disposed on the frame;

a drive track disposed below the frame and connected operatively to the engine for propulsion of the snowmobile;

two skis disposed on the frame;

a straddle seat disposed on the frame behind the engine, the seat being dimensioned to support a standard load having dimensions and weight of a 50-percentile human male, the load having a center of gravity [in a standard position in which the standard load straddles the seat while the snowmobile is on flat terrain];

a footrest positioned on each side of the seat; and

a steering device disposed on the frame forward of the seat, the steering device being operatively connected to the two skis for steering the snowmobile,

wherein the seat, each said footrest and the steering device are positioned and dimensioned with respect to one another so that the snowmobile 1) has a first center of gravity without the standard load and 2) has a second center of gravity [when] with the standard load [is in the standard position], and

wherein a distance between a vertical line passing through the first center of gravity and a vertical line passing through the second center of gravity is between 0 cm and 14 cm.

87. (New) A snowmobile, comprising:

a frame;

an engine disposed on the frame;

a drive track disposed below the frame and connected operatively to the engine for propulsion of the snowmobile;

two skis disposed on the frame;

a straddle seat disposed on the frame behind the engine, the seat being dimensioned to support a standard rider [with a center of gravity in a standard position in which the standard rider straddles the seat while the snowmobile is heading straight ahead on flat terrain], the standard rider having dimensions and weight of a 50-percentile human male; and

a steering device disposed on the frame forward of the seat, the steering device being operatively connected to the two skis for steering the snowmobile,

wherein the snowmobile has a first center of gravity without the rider and wherein the snowmobile is adapted to have a second center of gravity with the rider [in the standard position] such that, in use, a distance between a vertical line passing through the first center of gravity and a vertical line passing through the second center of gravity is between 0 cm and 14 cm.

89. (New) A snowmobile, comprising:

a frame including a tunnel having a forward-most drive track axle disposed thereon;

a straddle seat disposed on the frame above the tunnel;

an engine disposed on the frame in front of the seat;

two skis disposed on the frame; and

a steering device disposed on the frame and operatively connected to the two skis for steering the snowmobile;

wherein the snowmobile has a center of gravity without a rider, and wherein the center of gravity and the forward-most drive track axle are positioned rearward of a rearward-most portion of the steering device, and

wherein an angle between a line passing through the forward-most drive track axle and the center of gravity and a horizontal line passing through the forward-most drive track axle is less than 55°.

92. (Amended) An assembly comprising:

a frame including a tunnel;

a straddle seat mounted on the frame;

an engine disposed on the frame in front of the seat;

two skis disposed on the frame;

a steering shaft operatively connected to the two skis, the steering shaft being disposed over the engine at an angle ε of between 25° and 40° from vertical;

wherein the tunnel supports a drive belt coupled to the engine and defines a footrest on each side of the seat that is inclined at an angle Δ with horizontal that is between 0° to -10°; and

wherein a forward-most axle of the drive belt is positioned rearward of the steering [device] shaft.